

## REMARKS

### 1. Status of the Claims

Prior to this Response, Claims 1-10 were pending in the application and Claims 1-10 were rejected. No claims have been amended; as a result, claims 1-10 are now pending in this application. Accordingly, Applicant respectfully requests reconsideration of the above-identified patent application in view of the following remarks.

### 2. Rejection Under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to an art worker, to modify the reference or to combine reference teachings so as to arrive at the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations (M.P.E.P. §2143). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure (M.P.E.P. citing with favor, *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Applicant submits that a *prima facie* case of obviousness is not supported. A response to the Office Action rejection is provided below.

The Office Action relies upon the teaching of either (Parkay et al (US 5,742,955), Saladino (US 5,742,955), or May (US 5,650,228)) in view of JP 61225454 A and (Huber et al (US 6164021) or JP 05009454A) to render claims 1-10 of the present application unpatentable under 35 U.S.C. §103(a). Further, the Office Action stated that the cited art discloses all steps of the claimed method except the application of urethane foam as disclosed in the present application. Nevertheless, the Office Action takes an official notice that a use of urethane foam

for bonding a bath-liner to an existing bathtub would have been obvious in the art because (a) it is old in the art to form a water-proof film onto a base structure using a foamable polyurethane adhesive, where the structure is made of concrete, asphalt, metal, slate, etc. as exemplified in the teachings of JP '454 (abstract); and (b) Huber teaches using a foamable polyurethane adhesive for bonding roof tile which is made of "ceramic brick, stone, clay, plastic, wood, metal, rubber or bituminous materials" onto a base of a roof and for forming water-tight seal around "most troublesome areas" "to prevent the infiltration of wind-driven rain, hail or snow" (col. 1 line 18 to col. 2 line 47) or JP '454 teaches using a foamable polyurethane type adhesive for forming water-tight bonding of PVC pipes, panels, etc. (abstract), (Office Action, page 3, paragraph 2). Applicant respectfully traverses for the following reasons.

First, a careful reading of that portion of JP 61225454, Huber or JP 05009454 reveals absolutely no discussion concerning the application of urethane foam in bathtub replacement. Instead, Applicant asserts that JP 6122454, Huber and JP 05009454 are directed to solving a different problem than the present application.

JP 6122454 teaches the application of urethane foam on the surface of a base structure, wherein a waterproof film or sheet is applied on the urethane foam layer to form a waterproof layer on top of the surface of the base structure. There is no suggestion that the application of urethane foam on the surface of a base structure can also be used in a bath line replacement system.

Huber is directed to a hip and ridge roof sealing and attachment system, wherein the urethane foam seals the hip and ridge gaps and also provides the attachment mechanism for the hip tiles and ridge tiles. The application of the urethane foam on the hip and ridge roofing components provides resistance to wind uplift and additional support for traversing the tile (col.

6, lines 44-46). There is no suggestion that the application of urethane foam on the hip and ridge roofing components can be used in a bath line replacement system.

JP 05009454 teaches the application of urethane foam to give watertight adhesion to PVC pipe used as a rain gutter. Again, there is no suggestion that the application of urethane foam for adhering a rain gutter made of PVC pipe can be used in a bath line replacement system.

Also, contrary to the Office Action's contention that it would have been obvious in the art to use foamable polyurethane for bonding a bath-liner to an existing bathtub, the cited art specifically mentions all but urethane foam adhesive as the preferred adhesive material for use in bathtub replacement. Specifically, May patent teaches that an acrylic resin/methyl methacrylate monomer or other equivalent adhesives such as silicone or a catalytic adhesive or epoxy are commonly used in bath line replacement (col. 4, lines 66-67 and col 5. lines 1-16). Further, neither of Parkay nor Saladino patents suggests using urethane foam to bond bath lines. Therefore, the Office Action fails to either expressly or impliedly show motivation to combine the cited art because neither cited art recognized advantages discussed in the present application of using urethane foam in bath line replacement (para 0005 to 0008). Accordingly, a *prima facie* case of obviousness is unsupported over either of Parkay, Saladino, or May in view of JP 6122454, Huber or JP 05009454. For these reasons, Applicant respectfully requests reconsideration and reversal of the rejection of claim 1.

Claims 2-10 depend from independent claim 1. Accordingly, claims 2-10 include additional limitations to independent claim 1 and points to additional aspects or features regarding specific embodiments of the present application. For these reasons, Applicant submits that claims 1-10 are in condition for allowance.


3. Conclusion

Based on the above, the applicant submits that claims 1 is not taught, disclosed, or obviated by the references cited in the Office Action, and should therefore be in patentable condition as written. Further, the remaining claims in the application, namely claims 2-10, all depend from the above-mentioned claim, and therefore contain all limitations of that claim. Therefore, all of claims 1-10 should be in patentable condition as claimed. As such, reconsideration and passage to allowance of claims 1-10 is respectfully requested.

Respectfully submitted,

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Dated: February 9, 2006



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One of Applicant's Attorneys

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Patent Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on February 9, 2005.

Yolanda Solis

Name of Applicant, assignee, applicant's attorney or Registered Representative

